

To reject a claim based on anticipation, an individual reference must disclose each and every element as set forth in the claim. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987).

Claim 8 recites, in relevant part:

A method for posting debit information to a mobile intelligent storage device ... comprising the steps of:
performing a mutual dynamic authenticity test between the computer, the terminal and the storage device using at least one data word, the at least one data word constantly changing;

...
before an interrupt-sensitive time period,
transmitting a first data word of the at least one data word from the storage device to the terminal, the first data word being generated for the mutual dynamic authenticity test;

during the interrupt-sensitive time period,
transmitting a particular signal from the terminal to the storage device, the particular signal including a posting triggering signal, a posting data record, an identifier generated using the first data word and a second data word of the at least one data word generated by one of the computer and the terminal;

...
generating, by the storage device, a further identifier as a function of the second data word;
...

The Chaum reference purports to relate to automatic real-time highway toll collection from moving vehicles. In operation, a terminal (IVU) located within a vehicle prepares a "commit" data package during a non-communications stage and then transmits the package to a remote computer (RCS) when the IVU comes within communication range. (Chaum, col. 3, lines 10-24). If the RCS detects a valid commit data package, the RCS transmits a "challenge" data package to the IVU, including an amount of a toll to be deducted. (Chaum, col. 3, lines 25-36). If the IVU determines that the challenge package is valid, the IVU causes an appropriate toll amount to be debited from a smart card. (Chaum, col. 3, lines 37-42). The IVU then transmits a "payment" data package to the RCS, thereby acknowledging and concluding the transaction.

In support of this rejection, the Final Office Action apparently copies portions of the text of claim 8, intermittently repeating the following, a total of nine times, without further clarification, as "[r]esponse to attorney's arguments":

fig 4A (700, 702); fig 5A-B(see payment/center under complex frame protocol); fig 5D-C(see command time line with data frame which includes debit data and frame makers); col 23, line 41 to col 24, line 24; col 25, lines 52 to col 26, line 31, col 27, line 63 to col 28, line 52.

Final Office Action at pages 2-3. The Final Office Action also states that these responsive arguments “include *inherent* components in standard communications systems such as protocol handshake, identifiers, data streams with data stored in buffers,” etc (emphasis in original). As an initial matter, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic *may* occur in the prior art does not establish the inherency of that result or characteristic.

Furthermore, Applicants maintain that the Chaum reference does not disclose the details of how the IVU and the smart card communicate with each other. Thus, the Chaum reference is unrevealing with respect to critical features of claim 8, which include steps of communication between a vehicle’s terminal and the storage device (i.e., the smart card).

As for the new portions of the Chaum reference repeatedly cited in the Final Office Action, these section are addresses below, in turn.

Col. 23, line 41 to col. 24, line 24 of the Chaum reference describe how uplink data frames are structured and what data is included in each bit. This passage also discusses other features included in a data frame uplink, which are listed in TABLE 1, found in col. 17, lines 40 to 67, and how the data frames are checked for errors using a “Kryptor (a high speed RSA/DES encryption device).” The passage discusses the uplink only in terms of data sent **from the IVU to the RCS**. (See for example, Chaum, col. 5, lines 47-48, which recites, “The RCS maintains n uplink IVU buffers.”)

Col. 25, line 52 to col. 26, line 31 of the Chaum reference discuss the “challenge phase” of data downlink, where the, “RCS then transmits the challenge message to the IVU.” Col. 25, lines 55-56. The passage also includes a description of how the Kryptor is used in confirming the information transferred.

Col. 27, line 63 to col. 28, line 52 of the Chaum reference show tables 4-6 which detail "the three data packages involved in the data communication packages" for the commit message phase, challenge message phase, and payment message phase, discussed above on page 2 of this paper. Reference is made to Fig. 5, which shows that uplink occurs when data is transferred from the IVU to the RCS, and downlink occurs when data is transferred **from the RCS to IVU**.

In fact, the Chaum reference states that in the "preferred exemplary embodiment," which is the only embodiment described in the patent, "all real time data processing and data communication is done within and between the IVU and RCS." (Col. 4, lines 55-57). Additionally, it is explained that the IVU performs real time processing of the various data packages received from the RCS and verifies debiting of the electronic smart card. (Col. 8, lines 44-54).

The Chaum reference simply does not disclose the details of how the IVU **and the smart card** communicate. Therefore, the Chaum reference does not disclose at least the following features of claim 8.

1. "before an interrupt-sensitive time period, transmitting a first data word of the at least one data word **from the storage device to the terminal . . .**"
2. "during the interrupt-sensitive time period, transmitting a particular signal **from the terminal to the storage device**, the particular signal including a posting triggering signal, a posting data record, an identifier generated using the first data word and a second data word of the at least one data word . . ."
3. "generating, **by the storage device**, a further identifier as a function of the second data word . . ."

(Emphasis added.)

In summary it is respectfully submitted that the Chaum reference does not disclose, or even suggest, all of the features recited in claim 8. Therefore, the Chaum reference does not anticipate claim 8. As for claim 9-17, which depend from claim 8, it is respectfully submitted that the Chaum reference does not anticipate these claims for at least the same reasons given in support of the patentability of claim 8. Withdrawal of this rejection is therefore, respectfully requested.

III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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